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09/974,804	10/12/2001	Kouji Seino	1448.1016	7763
21171	7590	08/20/2007	EXAMINER	
STAAS & HALSEY LLP			LASTRA, DANIEL	
SUITE 700			ART UNIT	
1201 NEW YORK AVENUE, N.W.			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/974,804

Applicant(s)

SEINO, KOUJI

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44,46-50,52-57,59-64,66-72,74-79 and 81-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44,46-50,52-57,59-64,66-72,74-79 and 81-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. Claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, 81-95 have been examined. Application 09/974,804 (METHOD OF AND APPARATUS FOR DISTRIBUTING INFORMATION, AND COMPUTER PRODUCT) has a filing date 10/12/2001 and foreign data 06/28/2001.

Response to Amendment

2. In response to Non Final Rejection filed 02/27/2007, the Applicant filed an Amendment on 06/12/2007, which added new claims 93-95.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 93-95 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Said claims recite "wherein the second specification comprises a reply electronic mail including a keyword". Applicant's specification does not explain how by replying a keyword in an email there is a sorting of information.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 93-95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite "wherein the second specification comprises a reply electronic mail including a keyword". For purpose of art rejection, said limitation would be interpreted as using keywords for displaying stories in a website containing said keywords.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 56, 71 and 86 are rejected under 35 U.S.C. 102(e) as being anticipated by McCaskey (US 2002/0152245).

As per claims 56, 71 and 86, McCaskey teaches:

An apparatus for providing an electronic article stored in an article database to a client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see paragraphs 21, 145; McCaskey col 17, claim 62),

a receiving unit that receives a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by a user of the client computer (see McCaskey col 17, claim 62); an extracting unit that extracts a plurality of electronic articles from the article database based on the specification (see paragraphs 176-177, McCaskey col 17, claim 62);

a preparing unit that prepares an electronic mail based on the electronic articles extracted by the extracting unit (see paragraphs 176-179); and a transmitting unit that transmits the electronic mail prepared by the preparing unit to the client computer (see paragraphs 176-179; col 17, McCaskey claim 62).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44, 46-50, 52-55, 57, 59-64, 66-70, 72, 74-79, 81-85 and 87-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCaskey (US 2002/0152245) in view of Reilly (US 5,740,549).

As per claims 44, 57 and 72, McCaskey teaches:

An apparatus for providing an electronic article stored in an article database to a client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see McCaskey paragraphs 21, 145, 176-179; McCaskey col 17, claim 62);

a receiving unit that receives a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by a user of the client computer (see McCaskey paragraphs 176-177; McCaskey col 17, claim 62);

an extracting unit that extracts a plurality of electronic articles from the article database based on the specification (see McCaskey paragraphs 142-145; McCaskey col 17, claim 62);

a creating unit that creates a homepage based on the electronic articles extracted by the extracting unit and the advertisement extracted by the advertisement extracting unit and an uploading unit that uploads the homepage created by the creating unit to a predetermined website (see McCaskey paragraph 145);

an advertisement extracting unit that extracts an advertisement from an advertisement database (see McCaskey paragraphs 21,) but fails to teach based on the electronic articles extracted by the extracting unit. However, Reilly teaches a system that targets subscribers with headline news articles (see Reilly figure 6; col 13, lines 1-40) and upon said subscribers selection of those articles, presents said subscribers the

Art Unit: 3622

full version of said articles with corresponding advertisements (see Reilly col 13, lines 60-67). Furthermore, Reilly teaches a system that broadcasts email messages containing news items to register subscribers (see Reilly col 16, lines 55-60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that McCaskey would transmit electronic mails to subscribers, where said emails would contain summary of news (see McCaskey abstract) and upon said subscribers selection of articles in said summary, McCaskey would display a full version of said articles with corresponding advertisements, as taught by Reilly (see McCaskey paragraph 142) in a homepage in order to better target content and advertisements to said subscribers.

As per claims 46, 60 and 75, McCaskey fails to teach:

The apparatus according to claim 44, further comprising:

a number-of-times calculating unit that calculates a first number of times an advertisement is extracted from the advertisement database by the advertisement extracting unit, or a second number of times an advertisement is used for creating the homepage by the creating unit. However, Reilly teaches a system that calculates the number of times advertisements have been displayed in subscribers' computers in order to better target advertisements to said subscribers (see Reilly column 5, line 60 – column 6, line 10). Reilly does not expressly teach an accounting-fee calculating unit that calculates accounting fee incurred by an advertiser of an advertisement based on any one of the first number of times and the second number of times that correspond to the advertisement and are calculated by the number-of-times calculating unit. However,

it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Reilly would use advertising display statistics for the purpose of calculating advertisers' fees (see column 5, lines 53-60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that McCaskey would calculate advertisers' fee for placing advertisements in McCaskey's website using the advertisements displayed statistics, as taught by Reilly in order to better bill advertisers.

As per claims 47, 61 and 76, McCaskey teaches:

The apparatus according to claim 44, further comprising a website notifying unit that notifies the website to which the homepage is uploaded by the uploading unit to the client computer (see paragraph 78).

As per claims 48, 62 and 77, McCaskey teaches:

The apparatus according to claim 44, wherein the creating unit recreates the homepage when any one of the electronic articles extracted by the extracting unit and the advertisement extracted by the advertisement extracting unit is updated (see paragraph 130; McCaskey col 17, claim 64).

As per claims 49, 63 and 78, McCaskey teaches:

The apparatus according to claim 48, further comprising a recreation notifying unit that notifies the client computer that a recreation of the homepage has been performed (see paragraphs 130, 145).

As per claims 50, 64 and 79, McCaskey teaches:

An apparatus for providing an electronic article stored in an article database to a client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see paragraphs 21, 145 and 176-179);

a first receiving unit that receives a first specification from the client computer in response to the summary, the first specification specifying which electronic article is selected by a user of the client computer (see paragraph 176; McCaskey col 17, claim 62);

a first extracting unit that extracts a plurality of electronic articles from the article database based on the first specification (see paragraph 176; McCaskey col 17, claim 62);

a preparing unit that prepares an electronic mail based on the electronic articles extracted by the first extracting unit and the advertisement extracted by the first advertisement extracting unit (see column 2, lines 42-47; McCaskey col 17, claim 62);

a second receiving unit that receives a second specification from the client computer in response to the electronic mail prepared by the preparing unit, the second specification specifying which electronic article is selected by the user of the client computer (see paragraph 176; McCaskey col 17, claim 62);

a second extracting unit that extracts a plurality of electronic articles from the article database based on the second specification (see paragraphs 142-145);

a creating unit that creates a homepage based on the electronic articles extracted by the second extracting unit and the advertisement extracted by the second advertisement extracting unit (see paragraphs 142-145); and

an uploading unit that uploads the homepage created by the creating unit to a predetermined website (see paragraphs 142-145; McCaskey col 17, claim 63-64).

a first advertisement extracting unit that extracts an advertisement from an advertisement database and a second advertisement extracting unit that extracts an advertisement from the advertisement database (see paragraph 101) but fails to teach based on the electronic articles extracted by the first extracting unit and the second extracting unit. However, the same rejection made in claim 44 regarding this missing limitation is also made in claim 50.

As per claims 52, 67 and 82, McCaskey fails to teach:

The apparatus according to claim 50, further comprising:

a number-of-times calculating unit that calculates a first number of times an advertisement is extracted from the advertisement database by any one of the first advertisement extracting unit and the second advertisement extracting unit, or a second number of times an advertisement is used for any one of preparing the electronic mail by the preparing unit and creating the homepage by the creating unit. However, the same rejection applied to claim 46 regarding this missing limitation is also applied to claim 52.

As per claims 53, 68 and 83, McCaskey teaches:

Art Unit: 3622

The apparatus according to claim 50, further comprising a website notifying unit that notifies the website to which homepage is uploaded by the uploading unit to the client computer (see paragraph 130).

As per claims 54, 69 and 84, McCaskey teaches:

The apparatus according to claim 50, wherein the creating unit recreates the homepage when any one of the electronic articles extracted by the second extracting unit and the advertisement extracted by the second advertisement extracting unit is updated (see paragraph 101).

As per claims 55, 70 and 85, McCaskey teaches:

The apparatus according to claim 54, further comprising a recreation notifying unit that notifies the client computer that a recreation of the homepage has been performed (see paragraphs 130,145).

As per claims 59 and 74, McCaskey fails to teach:

The method according to claim 57, further comprising re-extracting another advertisement from the advertisement database when a display order of the electronic articles is changed at the client computer. However, Reilly teaches re-extracting another advertisement from the advertisement database when there is a changed in the display order of the electronic articles (see Reilly column 4, line 50 – column 5, line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that McCaskey would display advertisements to subscribers based upon said subscribers selections of news articles, where said advertisements displaying order would be linked to the electronic articles displayed

Art Unit: 3622

order, as taught by Reilly in order to target subscribers with advertisements based upon said subscribers selection of article in a summary of articles.

As per claims 66 and 81, McCaskey fails to teach:

The method according to claim 64, further comprising re-extracting another advertisement from the advertisement database when a display order of the electronic articles is changed at the client computer. However, the same rejection applied to claim 59 regarding this missing limitation is also applied to claim 66.

As per claims 87, 89 and 91, McCaskey fails to teach:

The apparatus according to claim 44, wherein a detailed level of the summary is determined by the user in advance. However, Reilly teaches determines the detailed level of displaying content in advance (see column 9, lines 35-60). Therefore, the same rejection applied to claim 44 regarding the obviousness of combining McCaskey with Reilly is also applied to claim 87.

As per claims 88, 90 and 92, McCaskey teaches:

The apparatus according to claim 44, wherein the specification further specifies whether a homepage is to be created or a electronic mail is to be prepared, and the creating unit creates the homepage when the specification specifies that a homepage is to be created (see paragraph 78).

As per claims 93-95, McCaskey does not expressly teach the apparatus according to claim 50, wherein the second specification comprises a reply electronic mail including a keyword. However, Official Notice is taken that it is old and well known in the communication art to reply to emails messages. Therefore, it would have been

obvious to a person of ordinary skill in the art at the time the application was made, to know that McCaskey would allow readers to reply to email, as it is old and well known to do so, where said reply email would contain keywords indicating the stories' topics that said readers would have chosen to be electronically mailed to them (see McCaskey paragraphs 70 and 78).

Response to Arguments

6. Applicant's arguments filed 06/12/2007 have been fully considered but they are not persuasive. The Applicant argues that in McCaskey "no specification is sent from the client computer in response to the summary". The Examiner answers that Applicant's claims recite "a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer; a receiving unit that receives a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by a user of the client computer; an extracting unit that extracts a plurality of electronic articles from the article database based on the specification". Said limitation simply recites allowing a client computer to select articles from a summary of articles and transmitting an article to said client computer from said selection. Applicant's specification does not have support for receiving a plurality of electronic articles by selecting a single article in a summary. McCaskey teaches providing a means for a subscriber to specify a plurality of selection criteria (*i.e.* plurality of articles) for news topic (*i.e.* summary), extracting new information according to subscriber selection criteria (*i.e.* plurality of articles) and preparing an electronic mail message of said news information (see McCaskey col 17, paragraph

62). Also, McCaskey teaches transmitting electronic mail summaries of news delivered to subscribers (see paragraph 21), where subscribers are hyperlinked to the complete histories of said news summaries (see paragraphs 142-143) when said subscribers select an article in said summaries. Therefore, contrary to Applicant's argument, McCaskey teaches Applicant's limitation.

The Applicant argues that in McCaskey there is no specification solicited from the subscriber at all. The Examiner answers that in McCaskey, everytime that a subscriber selects an article from the summary of articles transmitted to said subscriber, said subscriber is selecting or specifying the article that said subscriber wants to receive detailed information (see paragraphs 179). Therefore, contrary to Applicant's argument, McCaskey teaches the "specification" limitation.

The Applicant argues that McCaskey is not extracting a plurality of articles based upon the specification. The Examiner answers that everytime that a subscriber in McCaskey selects an article from a summary of articles transmitted to said subscriber via electronic mail, said subscriber is receiving a plurality of articles based upon said selection (see paragraph 179). Therefore, contrary to Applicant's argument, McCaskey teaches the "plurality of article" limitation.

The Applicant argues that in Reilly even if the headlines of the news stories were considered to be equivalent to the recited summary, and displaying the secondary component of a news story in Reilly upon subscriber request were considered to be equivalent to the recited specification, a subscriber may still only request the secondary component of a news article to be displayed but not extract a "plurality of electronic

articles from the article database based upon the specification". The Examiner answers Applicant's specification only has support for selecting an article in a summary of articles and receiving a detailed information of said selected article (see specification page 52). Applicant's specification does not have support for selecting a single article from a summary of articles and receiving a plurality of articles from said single article selection. Therefore, the limitation "the specification specifying which electronic article is selected by a user of the client computer and extracting a plurality of electronic articles from the article database based on the specification" is interpreted in light of the specification as simply obtaining detailed information from a summary of articles when a subscriber selects an article in said summary of articles. Therefore, the Applicant is arguing about limitation that are not supported by Applicant's specification.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3622

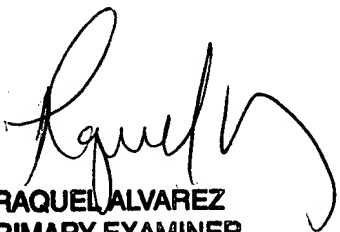
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra
August 11, 2007



RAQUEL ALVAREZ
PRIMARY EXAMINER